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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,787	07/31/2001	Jeffry J. Grainger	020313-000520US	4834

20350 7590 11/01/2007  
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EXAMINER

MOONEYHAM, JANICE A

ART UNIT	PAPER NUMBER
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3629

MAIL DATE	DELIVERY MODE
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11/01/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/919,787

Applicant(s)

GRAINGER ET AL.

Examiner

Janice A. Mooneyham

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 8/21/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

1. This is in response to the applicant's communication filed on August 21, 2007, wherein:

Claims 1-21 are currently pending;

Claims 1 and 19-21 have been amended.

***Claim Rejections - 35 USC § 112***

2. The rejections of claims 1-21 under 35 U.S.C. 112 has been withdrawn.

***Claim Rejections - 35 USC § 101***

3. The rejection of claim 20 under 35 U.S.C. 101 is hereby withdrawn.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**NOTE:** Claim Construction - "Automatically" - Without human interaction such that a human does not have to intercede and alter the flow. Process may be automatic even though human initiates or may interrupt *Collegenet, Inc. v Applyyourself, Inc.* (CAFC, 04-1202,1222-1251, 8/2/2005)

4. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al (US 2003/0046307) (hereinafter referred to as Rivette) in view of Petruzzi et al (US 6,049,811) (hereinafter referred to as Petruzzi).

Referring to Claims 1 and 19-21:

Rivette discloses a system, program and computer implemented method of managing electronic documents comprising:

a processor (Figure 11 (1106), paragraph [0285]) and computer readable medium in communication with the processor comprising a set of instructions executable by the processor for performing the method of [0289-0290];

providing a user with access to a plurality of electronic documents (Figure 3 (316), [0277] [0304], [0311] [0321][0376][0392][0402]) Figures 141-143);

maintaining an association at a computer system between a first set of electronic documents/references and a file ([0264-0265] group is a data structure that includes a collection of patents [0299] [0311] document database includes electronic representations of documents of interest to the customer [0313] prior art references [0330-0332] Groups databases; Figure 153 (15302)) ;

maintaining an association at the computer system between a second set of electronic documents/references and a second file [0373—0377] provides the customer with the ability to quickly, efficiently and effectively access, display and process any patent of interest; [0393] [0396] the client searching module displays the search results and enables the user to manipulate and process the search results (such as by enabling the user to add the documents identified by a search to a new or existing group);

providing an interface element that is configured to **allow** a user to invoke a display of a list of references ([0393] [396] [0396] client searching module displays the search results);

receiving, at the computer system, an input responding to the element ([0392] (0407] if the user selects by double clicking or other well known GUI operation such as selecting a patent and pressing a return button) [0217 double clicking [1222-1228];

in response to the input, displaying a list of the references [0392] [1214-1215];

providing an interface element that is configured to **allow** the user to identify the reference as being relevant [0392] [0393] [0396] [1217];

receiving at the computer system a second input and in response to the input, associating, via an automated process the reference with the file [0392-0394] drag and drop techniques [1157] [1193] [1247-1248];

While Rivette discloses searching and storing and retrieving relevant documents to a patent application, Rivette does not disclose using the information in the process of generating an electronic information disclosure statement, the electronic information disclosure statement comprising a plurality of fields and creating the electronic information disclosure statement by extracting information form the reference via an automated process and storing the information in the electronic information disclosure statement.

However Petruzzi discloses an electronic information disclosure statement with a plurality of fields and incorporating, with an automated process, at least some of the extracted information from the electronic document into an electronic information statement wherein the at least one electronic document includes information corresponding to a plurality of fields in the electronic information disclosure statement, and wherein incorporating at least some of the extracted information comprises storing

the information in the corresponding plurality of fields in the IDS (Figure 2 (Forms 39) col. 2, lines 65-67 col. 5, line 48 thru col. 6, line 7 The Form 1449 for submitting information in the form of patents, publications, etc is provided, operator is prompted for references, a brief description of each reference and the relevance. After information is inputted, the computer automatically generates a first draft).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the searching and storage of relevant documents disclosed in Rivette the electronic IDS taught in Petruzzi so that once the relevant documents are identified, the applicant is able to comply with the rules and regulations of the patent office by submitting the relevant prior art as required.

The Examiner notes that the association indicates that each of the references in the first set of references are relevant to the patent application and should be disclosed to a patent office, further defines the reason for the association but does not further define the steps of the method. The reason for making the association does not affect the steps of the method and thus is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; *see also Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981).

However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the data identifying the reason for the association adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the data identifying the reason for the association does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

Referring to Claims 2-3:

Rivette discloses displaying for the user a file and links to each reference (Figure 145A [0125-0126] [1222]) [1232-1233]).

Referring to Claim 4:

Rivette discloses displaying identifiers corresponding to each of the references in individual rows of a first column, wherein the rows include a marker. (The Examiner is unclear what the applicant is trying to claim with this language, but applies prior art as best as the Examiner understands the claim language)(Figure 6 [0303-0309], Figures 13-17, Figures 33-38).

Furthermore, the language identifying what is in the display is non-functional descriptive data – see explanation above.

Referring to Claims 5-9:

Rivette discloses wherein patent applicants are related, have a common inventor, have the same assignee, or are related as continuations/continuation-in-part [0261-0262] [0307] [0349-0357] [0373-0379] [1157-1159] [0133] Figure 100.

Referring to Claim 10:

Rivette discloses displaying a search screen to search for additional cases (Figure 53) [0388-0417 Searching Module]). (The Examiner notes that a search screen is displayed but there is no positive recitation of a search being performed).

Referring to Claims 11-13:

Rivette discloses wherein the electronic documents is an electronic version of a US Patent or a foreign patent document, or a publication [0376].



Referring to Claims 14-15:

Rivette discloses wherein providing a user to a plurality of references comprises storing a plurality of references/information from a plurality of references in a database [0373-0379], [0453] [1157-1159],[1193].

Referring to Claim 16:

Rivette discloses allowing the user to search the web for references [0484-0485] [1209-1212].

Referring to Claim 17:

Rivette discloses allowing the user to search a database, wherein the database is maintained by an official patent office [0321].

***Response to Arguments***

Applicant's arguments filed August 21, 2007 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

As for applicant's arguments as to the newly amended claim language, the Examiner has addressed this in the body of the rejection.

As for applicant's arguments that Petruzzi does not disclose the limitations of claim 21, the Examiner disagrees for the reasons set forth in the body of the rejection.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Application/Control Number:  
09/919,787  
Art Unit: 3629

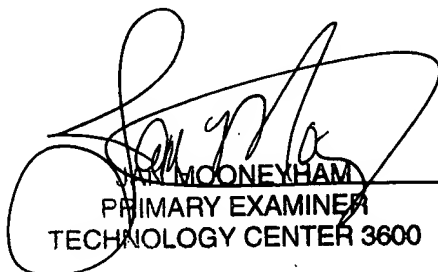
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JM

  
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